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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,056	09/21/2000	David L. Adams	3339 P 005	9810

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EXAMINER

HIRL, JOSEPH P

ART UNIT

PAPER NUMBER

2121

DATE MAILED: 02/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/668,056

Applicant(s)

ADAMS ET AL.

Examiner

Joseph P. Hirl

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on December 8, 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to an AMENDMENT entered December 8, 2003 for the patent application 09/668,056 filed on September 21, 2000.

2. The First Office Action of June 4, 2003 is fully incorporated into this Final Office Action by reference.

3. The claims and only the claims form the metes and bounds of the invention.

"Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, I 45-48; p 2100-9, c 1, I 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

4. Examiner's Opinion:

Para 3 above applies. Claims form the metes and bounds of the invention and the crafting of the claims is most important to a successful disclosure. The applicant is encouraged to fully respond to all points made in an office action.

Status of Claims

5. Claims 1-30 are pending.

New Matter

6. The amendment filed December 8, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "Procedural conversations have a required (demand as necessary) sequence..." (specification page 4, lines 19-20) is quite different from "... enforced (to urge with energy) sequence ..." (definitions from Merriam-Webster's Collegiate Dictionary, Tenth Edition, emphasis added).

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

7. The objection to the drawings is withdrawn.
8. The objection to the specification is withdrawn.

9. Applicant's arguments filed on December 8, 2003 related to Claims 1-30 have been fully considered but are not persuasive.

In reference to Applicant's argument:

Claims 1, 3-13, 16, and 18-28 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Specifically, the Office Action alleges that the specification does not address "enforced sequence of tasks." Applicants respectfully traverse this rejection and submits that the "required sequence" discussed on page 7, line 27, is an example of the enablement of this claim term in the original specification. Nonetheless, this line of the specification has been amended to more clearly indicate the equivalents of the term required and "enforced." Accordingly, Applicants respectfully request reconsideration of withdrawal of this rejection.

Claims 4, 10, 19, and 25 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement due to an alleged failure to address "required leaf task." Applicants respectfully traverse this rejection and submits that first leaf tasks are clearly defined on page 8, line 6-7 of the specification. Additionally, steps 454 and 456 of Figure 4c teach one of ordinary skill in the art to make and use this feature. Specifically, step 454 includes a check to determine whether a current task is a leaf task and subsequent step 456 checks to determine whether this leaf task is required. Thus, Applicants respectfully submit that this term is enabled by the specification to teach one of ordinary skill in the art to make and use the features of these claims.

Claims 5, 11, 20, and 26 were rejected under § 112, first paragraph, based on the allegation that the specification does not address "non-required leaf tasks." Applicants respectfully traverse this rejection and submits that steps 454 and 456 of Figure 4c again enabling one of ordinary skill in the art to make and use this feature. In particular, step 454 determines if the current task is a leaf task. If so, the algorithm determines in step 456 whether the current task is required. If the current task is not required then, a priori, the result is a determination of a non-required leaf task. Accordingly, Applicants respectfully submit that this term is enabled in accordance with the requirements of § 112, first paragraph, and request that the rejection be withdrawn.

Claims 6, 12, 21, and 27 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to enable the term "complete, non-leaf task." Applicants respectfully traverse this rejection and submits that steps 454 and 466 of Figure 4c, as an example enables this claimed feature. In particular, step 454 determines whether or not a current task is a leaf task. If the task is not a leaf task then, logically, this task is a non-leaf task. Additionally, in subsequent step 466 at determination as to whether the current task, which, by virtue of the decision in step 454, is a non-leaf task, is complete. Thus, the term "complete, non-leaf tasks" is enabled to one of ordinary skill in the art in order to make and use this claimed feature. Accordingly, Applicants respectfully submit that this term is enabled and request the withdrawal of the rejection, accordingly.

Claim 7, 13, 22, and 28 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to enable the term "incomplete, non-leaf tasks." Applicants respectfully traverse this rejection and submits that, as discussed above, step 454 of Figure 4c, as an example, teaches one of ordinary skill in the art to determine between leaf and non-leaf task. Further, step 466 determines whether or not non-leaf task or complete or incomplete. Accordingly, Applicants respectfully submit that this term is enabled according to the requirements of § 112, first paragraph and request that this rejection be withdrawn, accordingly.

Examiner's response:

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Para 3 above applies. The applicant admits that in each situation cited, the specification is silent concerning the related term with the exception of the "new matter" that is to be dealt with as identified above. It is well established that the claims and only the claims form the metes and bounds of the invention. One must be precise in the crafting of the claims such that when reference is given to the specification, one of ordinary skill in the art can replicate the invention without undue experimentation. The rejection as identified in the first office action remains.

In reference to Applicant's argument:

Claims 1-28 were rejected under 35 U.S.C. §101 due to an allegation that the claims lack patentable utility. The Office Action states, correctly, that the practical application test requires that a useful, concrete and tangible result be accomplished. Such a result is indeed found in these claims. Specifically, the claimed methods of independent claims 1 and 14, for example, generate a list of possible statements in response to the received statement for the learner to make from the statements contained within the dynamic data model. Such a list of possible statements is indeed a useful, concrete and tangible result and, thus, these claims do not run afoul of the requirement of 35 U.S.C. §101. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Examiner's response:

As stated in the First Office Action on page 4, line 17, the issue with claims 1-28 is abstract methodology and specifically claims 1-28 are not tangibly embodied in the practical application of the technological arts. A dynamic data model is abstract methodology...it is not tangibly embodied.

In reference to Applicant's argument:

The Office Action asserts that Lannert et al. discloses all of the elements of claims 1, 14 and 29. In particular, the Office Action asserts that Lannert et al., among other things, teaches generation of a list of possible statements in response to a received statement for a learner to make from statements contained within a dynamic data model. In support of this assertion, it appears the Office Action references column 11, lines 23-36 of Lannert. The teachings of Lannert, however, do not actually teach generation of a list of possible statements in response to a received statement for the learner to make from the statements contained within a dynamic data model as featured in the claim, but rather, merely teaches in general terms a simulation model. The Intelligent Coaching Agent (ICA) taught by Lannert, for example, merely generates feedback based on a set of rules. This feedback, however, is not taught or suggested to be akin to a software code that generates a list of possible statements in response to a received statement from a learner, which are for use by the learner to make in the simulation. Accordingly, Applicants respectfully submit that this element, for example, is not taught or suggested by Lannert et al.

Examiner's response:

Para 3 above applies. Lannert at c 11, l 23-36 invokes reference to a simulation engine (dynamic data base model), which, of course, has simulation software. The simulation engine receives input from the student and the simulation engine generates feedback to the student. The simulation engine is synonymous with the dynamic data base model. To one of ordinary skill in the art, feedback from the simulation engine will indeed be software initiated...that's how a computer operates.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

11. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Lannert et al (U. S. 6,029,156, referred to as **Lannert**).

Claims 1, 14, 29

Lannert anticipates providing simulation software code (**Lannert**, col 11, lines 13-20); providing a dynamic data model comprising tasks and statements (**Lannert**, col 10, lines 60-67; col 11, lines 1-12); receiving a statement made by the learner (**Lannert**, col 11, lines 13-20); and generating a list of possible statements in response to the received statement for the learner to make from the statements contained within the dynamic data model based on at least one of: a. whether the current conversation has an enforced sequence of tasks, b. whether the current task allows the learner to move to a

sibling task, c. whether the current conversation requires completion; d. whether the current task is a leaf task, e. whether the current task is a required task, or f. whether the task is complete (**Lannert**, col 11, lines 23-36; Examiner's Note (EN): Applies to each consideration).

Claims 2, 17

Lannert anticipates the dynamic data model is independent from the simulation software code (**Lannert**, Fig. 2).

Claims 3-13, 16, 18-28

EN: These claims all contain various terminology identified above that maybe unique to this application but has not been enabled in the specification and virtually makes it impossible to realistically establish the metes and bounds of such claims. However, in the spirit of expeditious prosecution, the Examiner has reviewed each claim and the following points in summary are appropriate:

- a. Lannert and Fig. 57 of Lannert apply to each of these claims.
- b. Lannert and Fig. 57 has transition conditions, candidate statements, current tasks, conversation, ancestors, enforced sequence of tasks, siblings, leaf tasks, required and incomplete considerations.
- c. Para 2 above applies. Among other interpretations, the Examiner has established the following perspective: Statements are options; conversation is subject matter; enforced sequence of tasks is protocol, algorithms, process etc.; sibling is same level; ancestor is level above; child is the level below; leaf task is nothing follows; required sets forth the next or following step; incomplete is in process. As an example,

in the case of Claim 3, Lannert anticipates candidate statements of the current task when the conversation has an enforced sequence of tasks and the task allows the learner to move to a sibling task (**Lannert**, Fig 57; EN: candidate statements (Finance or Present Business Case); current task (Present Business Case); conversation (of a business nature); enforced sequence of tasks (001 – Intro – What is BDM – 000 BDM Child 1 – BDM Child 1); and siblings to move to (Target Pages- Target Groups).

Claims 15, 30

Lannert anticipates the step of determining whether the received statement completes a current task (**Lannert**, col 11, lines 23-36; EN: The purpose of Lannert' teachings is Goal Based Tutoring which would in consequence mean that at a time t, the received statement from the student would complete a current task. There would be nothing novel about such an effort.)

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Claims 1-30 are rejected.

Correspondence Information

Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner, Joseph P. Hirl, whose telephone number is (703) 305-1668. The Examiner can be reached on Monday – Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anil Khatri can be reached at (703) 305-0282.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,

Washington, D. C. 20231;

or faxed to:

(703) 746-7239 (for formal communications intended for entry);

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or faxed to:

(703) 746-7290 (for informal or draft communications with notation of
"Proposed" or "Draft" for the desk of the Examiner).

Hand-delivered responses should be brought to:

Receptionist, Crystal Park II

2121 Crystal Drive,

Arlington, Virginia.

Joseph P. Hirl

February 12, 2004



ANIL KHATRI
SUPERVISORY PATENT EXAMINER